



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,599	11/29/2001	Masayasu Ogushi	216644US0	2699
22850	7590	11/08/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			AUGHENBAUGH, WALTER	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/995,599

Applicant(s)

OGUSHI ET AL.

Examiner

Walter B Aughenbaugh

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 September 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See continuation sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1,2,8,10,11 and 15.Claim(s) withdrawn from consideration: 16.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claims 1 and 11 in the After Final Amendment filed October 12, 2004 (Amdt. B) have been received, considered and entered by Examiner.
2. The cancellation of claims 9, 13 and 14 in Amdt. B has been entered.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. 103(a) rejection of claim 9 made of record in paragraph 13 of the Final Rejection has been withdrawn due to Applicant's cancellation of claim 9 in Amdt. B.
4. The 35 U.S.C. 103(a) rejection of claims 13 and 14 made of record in paragraph 14 of the Final Rejection has been withdrawn due to Applicant's cancellation of claims 13 and 14 in Amdt. B.

REPEATED REJECTIONS

5. The 35 U.S.C. 102(e) rejection of claims 1, 8 and 15 made of record in paragraph 11 of the Final Rejection has been repeated for the reasons previously made of record in paragraph 11 of the Final Rejection.
6. The 35 U.S.C. 103(a) rejection of claims 2, 10 and 11 made of record in paragraph 12 of the Final Rejection has been repeated for the reasons previously made of record in paragraph 12 of the Final Rejection.

ANSWER TO APPLICANT'S ARGUMENTS

7. The Declaration under 37 C.F.R. 1.132 filed October 12, 2004 has not been considered because it is not directed solely to issues which were newly raised by Examiner in the final rejection. Applicant states in paragraph 4 of the Declaration that experiments were conducted "to

Art Unit: 1772

prove that the endotracheal tube of the present invention is superior in transparency to an endotracheal tube in which an ethylene/propylene copolymer as disclosed in US 6,184,291 B1 is used". Applicant argued "if Ahmed's ethylene interpolymer is used... an endotracheal tube with excellent transparency cannot be obtained"; therefore, the issue of transparency was not newly raised by Examiner in the final rejection. The US 6,184,291 B1 patent was relied upon in both the non-final and final rejections, not solely in the final rejection.

8. Applicant's arguments regarding the 35 U.S.C. 102 rejection of claims 1, 8 and 15 made of record in paragraph 11 of the Final Rejection presented on pages 5-6 of Amdt. B have been fully considered but are not persuasive. Applicant argues that the TAFMER polymer taught by Ahmed "is not a homopolymer", but there is no requirement that the polypropylene of claim 1 be a homopolymer: an ethylene-propylene copolymer is a polypropylene. Applicant argues that "if Ahmed's TAFMER P0480 ethylene/propylene copolymer is used in place of polypropylene, an endotracheal tube with excellent transparency cannot be obtained", but an endotracheal tube with excellent transparency is not claimed. The Declaration under 37 C.F.R. 1.132 filed October 12, 2004 has not been considered for the reasons provided above.

9. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claims 2, 10 and 11 made of record in paragraph 12 of the Final Rejection presented on pages 6-7 of Amdt. B have been fully considered but are not persuasive. Applicant argues that Sterling does not teach the specific block copolymer of claim 1, but Ahmed teaches the block copolymer of claim 1, and Sterling is relied upon to teach that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the resin of Ahmed into a cuff as claimed in claim 2 for the reasons provided in paragraph 12 of the Final Rejection, not to teach the block copolymer of

Art Unit: 1772

claim 1. In the sentence bridging pages 6 and 7 of Amdt. B, Applicant argues that Sterling fails to teach a limitation of claim 1, but Ahmed teaches this limitation as made of record in paragraph 11 of the Final Rejection. Applicant argues that the “prima facie case of obviousness based on the cited prior art is rebutted by the significant improvement in transparency achieved by the present invention”, but the Declaration under 37 C.F.R. 1.132 filed October 12, 2004 has not been considered for the reasons provided above.

Applicant argues in the last sentence of the first full paragraph of page 7 that “Ahmed fails to suggest an elastomeric composition containing polypropylene in the recited amounts”, but the ethylene-propylene copolymer taught by Ahmed is a polypropylene, and Ahmed teaches a weight ratio value that falls within the claimed weight ratio range as made of record in paragraph 11 of the Final Rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

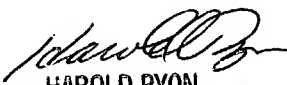
Art Unit: 1772

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

11/04/04

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/4/04